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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,331	02/08/2002	Henri Samain	05705.1016	1336
22852	7590	06/30/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

10/019,331

**Applicant(s)**

SAMAIN ET AL.

**Examiner**

JYOTHSNA A VENKAT

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/9/04 has been entered.

Claims 21-52 are pending in the application and the status of the application is as follows:

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 21-52 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a written description rejection.**

To satisfy the Written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that applicant were in possession of the claimed invention. Applicant's claims are drawn to "*a cosmetic hair composition comprising in a cosmetically acceptable medium, solid particles and at least one adhesive polymer wherein when the composition is dried, the resulting dried material has detachment profile defined by at*

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*least one maximum detachment force  $F_{max}$  of greater than 1N., wherein  $F_{max}$ , as measured by extensometer, is the maximum tensile force needed to detach the surfaces of two respective rigid, inert, nonabsorbent supports (A) and (B), wherein said surfaces have each have a surface area of  $38\text{ mm}^2$  and wherein said supports are placed facing each other; and further wherein: said surfaces are precoated at a concentration of 53/c micrograms/ $\text{mm}^2$  with a formulation comprising said at least one adhesive polymer in the cosmetically acceptable medium, where in c is the concentration of solids in the formulation, expressed in grams per gram of composition; and said precoated surfaces are dried for 24 hours at  $22^{\circ}\text{C}$ , under a relative humidity of 50%, then subjected for 20 seconds to a compression of 3N, and then subjected to detachment at a speed of 20 mm/minute for 30 seconds to determine  $F_{max}$ .*

The instant application fails to describe specific examples of adhesive polymers that satisfy the criteria of claims 21-26. The specification describes the adhesive polymer, which satisfies this criterion, at page 4 as AQ 1350 sold by Eastman Kodak. There is no structure given to this polymer except for the trademark name. This polymer has the detachment force  $F_{max}$  greater than 1. This is the only polymer described and exemplified. The criteria for the dried material in claim 24 is that the dried material has a glass transition temperature of less than  $+10^{\circ}\text{C}$ . The AQ polymer has a glass transition temperature of  $0^{\circ}\text{C}$ . The functional language recited in the claims without defining the suitable adhesive polymers, does not meet the written description requirement as one of ordinary skill in the art could not recognize or understand the polymers that satisfy the requirement from the mere recitation of the function. Claims employing functional language at the point of novelty, such as applicants', neither provide those elements required to practice the inventions, nor "inform the public" during the life of the patent of the

limits of the monopoly asserted. Applicants claimed expression represents only an invitation to experiment regarding possible polymers suitable as adhesive polymers, which can be used in the cosmetic compositions.

***Response to Arguments***

3. Applicant's arguments filed 6/9/04 have been fully considered but they are not persuasive.
4. Applicants argue that to satisfy the written description requirement, a specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had "possession" of the claimed invention. Under the law, "possession" may be shown in a number of ways, including by describing an actual reduction to practice, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. Thus, the detailed language of the claims themselves is sufficient to demonstrate to one skilled in the art that applicants had possession of the invention when the application was filed. The present claims recite a cosmetic hair composition that has very specific properties that are understood by one skilled in the art. This is not mere "functional" language, as asserted by the Examiner, but rather, a listing of particular physical properties of the composition. Applicants also submit U. S. Patent 5,543,48 ('488) exhibit A and point out to examples 2-4 that describe the branched sulfonic polymer AQ 1350 and product brochure by Eastman (appendix B) which describes the branched sulfonic polymer AQ 1350 and argue that one skilled in the art would have access to and understand the '488 patent just as one skilled in the art would have access to the full description of the AQ 1350 and point out that the claims complies with written description requirement.

In response to the above argument, it is the position of the examiner that the specification describes “ branched sulfonic polymer AQ 1350 “sold by the company Eastman”. The exhibit B clearly specifies the glass temperature as  $-2$  degrees C. The examples 2-4 of the U. S. Patent ‘488 is not drawn to AQ 1350 polymer since the glass transition temperature is not same to that disclosed in the product Brochure. Note that all the polymers described in the brochures exhibits B-D are branches sulfonic esters. All the properties are not same. The glass transition temperature is different. **Additionally under 102 (b) rejection applicants argue that the adhesive polymers disclosed in the patent are not the same to that claimed and with respect to 112, written description applicants argue that mere recitaion of one polymer with specific glass transition temperature complies with written description requirement.** In conclusion the claims reciting *a cosmetic hair composition comprising in a cosmetically acceptable medium, solid particles and at least one adhesive polymer wherein when the composition is dried, the resulting dried material has detachment profile defined by at least one maximum detachment force  $F_{max}$  of greater than 1N., wherein  $F_{max}$ , as measured by extensometer, is the maximum tensile force needed to detach the surfaces of two respective rigid, inert, nonabsorbent supports (A)and (B) , wherein said surfaces have each have a surface area of  $38\text{ mm}^2$  and wherein said supports are placed facing each other: and further wherein:*

*said surfaces are precoated at a concentration of 53/c microgrqrams/ $\text{mm}^2$  with a formulation comprising said at least one adhesive polymer in the cosmetically acceptable medium, where in c is the concentration of solids in the formulation, expressed in grams per gram of composition ; and*

*said precoated surfaces are dried for 24 hours at  $22^0$  C, under a relative humidity of 50%, then*

*subjected for 20 seconds to a compression of 3N, and then subjected to detachment at a speed of 20 mm/minute for 30 seconds to determine  $F_{max}$ .*

5. It is the position of the examiner that the specification does not convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention drawn to **all the adhesive polymers satisfying the criteria described in the claims.**

6. Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a new matter rejection.**

7. There is no support in the specification for “ketones, alkyl acetates, and di-alkoxy substituted alkanes”. the specification describes at page 10, 2<sup>nd</sup> paragraph two compounds under ketones, which are acetone and methyl ethyl ketone. The same is true for acetates and di-alkoxy substituted alkanes. Description for two specific compounds in each category is not a support for the entire genus.

#### ***Response to Arguments***

8. Applicant's arguments filed 6/4/04 have been fully considered but they are not persuasive.

9. The gist of applicant's arguments is that the recitation of at least two species contained within each genus constitutes a sufficient number of species to describe the entire genus.

10. In response to the above argument, the expression “claimed” is outside the scope of the description in the specification (emphasis added) and therefore the claimed expression is new matter.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 21-23, 25-26, 28-38, and 42 are, rejected under 35 U.S.C. 102(b) as being anticipated by U. S. patent 5,053,221 (‘221).

13. The claims are drawn to compositions and claims recite the functional language which is *when the composition is dried, the resulting dried material has detachment profile defined by at least one maximum detachment force  $F_{max}$  of greater than 1N., wherein  $F_{max}$ , as measured by extensometer, is the maximum tensile force needed to detach the surfaces of two respective rigid, inert, nonabsorbent supports (A) and (B), wherein said surfaces have each have a surface area of  $38\text{ mm}^2$  and wherein said supports are placed facing each other: and further wherein:*

*said surfaces are precoated at a concentration of 53/c micrograms/ $\text{mm}^2$  with a formulation comprising said at least one adhesive polymer in the cosmetically acceptable medium, where in c is the concentration of solids in the formulation, expressed in grams per gram of composition ; and*

*said precoated surfaces are dried for 24 hours at  $22^0\text{ C}$ , under a relative humidity of 50%, then*

*subjected for 20 seconds to a compression of 3N, and then subjected to detachment at a speed of 20 mm/minute for 30 seconds to determine  $F_{max}$ .*

The office is not equipped to manufacture the composition and then drying the composition so that it satisfies the functional criteria of claims 21-26. Therefore the claims are anticipated, absence of evidence to the contrary.

See col.2, lines 30-45 for the beads, which read on the claimed particles. See col.2, lines 38-39 where the patent discloses that when “ the silica beads are the only micro sphere particles. “. There is overlap of concentration and particle size. See the paragraph bridging col.s 3-4 for the adhesive polymer and see col.4, lines 18 et seq and col.5, lines 1-60 for the AQ polymers. The polymer disclosed in the patent reads on the claimed adhesive polymer. See the examples for ethanol which read on the solvent, see col5, lines 60 et seq and col.6 for the additives.

#### ***Response to Arguments***

14. Applicant's arguments filed 6/4/04 have been fully considered but they are not persuasive.

Applicants argue that the patent only discloses spherical particles where as the solid particles of claimed invention are flakes, platelets, fibrils and powders.

In response to the above argument, only claim 27 specifies the particles and inn view of applicant's response the rejection of claim 27 is withdrawn and the independent claim does not recite the particles in the Markush group.

Applicants point out hat the AQ polymers disclosed in the patent would provide the instantly claimed profile since the AQ polymers have different glass transition temperature and hydroxyl numbers of less than 10, where as AQ 1350 has a hydroxyl number of 28.

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In response to the above argument, the rejection of claim 24 under 102(b) is withdrawn since the claim specifies the glass temperature of less than +10 degrees C. The claim 21 does not specify the glass temperature or the hydroxyl number. Therefore 102 rejection is deemed proper. In order to complete the record, applicants are requested to provide the examiner the AQ polymers that are made by Eastman under AQ, which has hydroxyl number 28 and glass transition temperature other than the exhibits B-D. Additionally the glass transition temperature described in the specification is zero degrees, where as the product brochure describes the glass temperature as -2 degrees. Clarification is requested with respect to discrepancy.

15. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

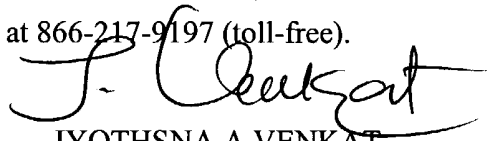
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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JYOTHSNA A VENKAT  
Primary Examiner  
Art Unit 1615

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